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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,182	03/25/2004	Kuniharu Umeno	033036.076	6820
25461 7590 01/17/2007 SMITH, GAMBRELL & RUSSELL SUITE 3100, PROMENADE II 1230 PEACHTREE STREET, N.E. ATLANTA, GA 30307-3592			EXAMINER SELLERS, ROBERT E	
			ART UNIT 1712	PAPER NUMBER
			MAIL DATE 01/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/809,182	Applicant(s) UMENO ET AL.	
	Examiner Robert Sellers	Art Unit 1712	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3 and 6-9.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: Form PTO-892, Notice of References Cited.

Robert Sellers
Primary Examiner
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1. Table 1 as amended in the response filed January 4, 2007 deletes Examples 8 and 9 in original Table 1 containing 0.05 part by weight of catechol and pyrogallol, respectively, and renumbers Examples 10-13 of original Table 1 as Examples 8-11.
2. The modification of R_2 in phenol resin (B) of general formula (2) on page 3, lines 11-12 of the specification to include hydrogen substantiates R^2 of general formula (2) in independent claim 2.
3. Compound (F) described on page 3, lines 14-16 has been more clearly defined as "containing two or more hydroxyl groups on adjacent carbon atoms." Such language should also be instituted on page 13, lines 4-5 for the sake of consistency and a more concise denotation of the position of the hydroxyl groups.
4. The declaration filed January 4, 2007 is deficient because Japanese priority application no. 2003-083938 is misnumbered as 2003-833938.
5. The continuation-in-part status of the instant application on Umeno et al. application no. 10/797,706, U.S. Patent No. 7,023,098 in the amendment filed October 30, 2006 is acknowledged. However, the general formula (1) of epoxy resin (A) of the instant claims has a value for the repeating unit defined by "n" of from 1 to 10 which is broader than that of application no. 10/797,706 wherein "n" is from more than 0 up to 5. General formula (2) of phenol resin (B) in the instant claims is not depicted in application no. 10/797,706.

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6. Accordingly, the filing date for these features is the filing date of the instant application of March 25, 2004 antedated by the filing date of March 10, 2004 for Umeno et al. The filing date of Umeno et al. can be antedated by the submission of certified English equivalents for Japanese priority application nos. 2003-083937 and 2003-083938 contingent upon the support for the claimed range of "n" in general formula (1) and the depiction of general formula (2). Such submissions will not be considered unless presented in a Request for Continued Examination since there is no reason why they could not have been submitted in previous responses.

7. The limitation of Compound (F) to a compound containing adjacent hydroxyl groups on a naphthalene ring as denoted in cancelled claim 5 overcomes the 35 U.S.C. 103(a) over Japanese Patent No. 2003-29730 disclosing monophenyl hydroxyl compounds (translation, page 3, paragraph 10) in view of Japanese Patent No. 3-29352 confined to monophenyl hydroxyl compounds as exhibited on page 336, the structure in the second column of the patent.

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8. The obviousness-type double patenting rejection over Umeno et al. remains available as a reference since the instant application is not a divisional of the application wherefrom the patent issued. Umeno et al. (col. 4, lines 30-31) discloses a phenolaralkyl containing a biphenylene structure as another epoxy resin (col. 4, lines 30-31) embracing the claimed diglycidyl ether of a phenol biphenylmethylenes resin of general formula (1) along with a phenol phenylmethylenes resin exemplified by XLC-LL which contains moieties within the claimed phenol resin of formula (2) according to Chemical abstracts registry no.26834-02-6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
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